



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/813,606

03/31/2004

Robert Joseph Angen

64367.000002

4352

21967

7590

03/04/2010

HUNTON & WILLIAMS LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109

EXAMINER

KRAMER, JAMES A

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

03/04/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2  
3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* ROBERT JOSEPH ANGEN and JOHN GARRETT PENN II  
9

10  
11 Appeal 2009-010449  
12 Application 10/813,606  
13 Technology Center 3600  
14

15  
16 Decided: March 4, 2010  
17

18  
19 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and  
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Robert Joseph Angen and John Garrett Penn II (Appellants) seek review  
3 under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-18, the only  
4 claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
6 (2002).

7 SUMMARY OF DECISION<sup>1</sup>

8 We AFFIRM.

9 THE INVENTION

10 The Appellants invented a display assembly for use in displaying  
11 objects, such as collectibles, models, or other display objects (Specification  
12 1:Field of the Invention).

13 An understanding of the invention can be derived from a reading of  
14 exemplary claim 1, which is reproduced below [bracketed matter and some  
15 paragraphing added].

---

<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 10, 2008) and Reply Brief ("Reply Br.," filed March 6, 2009), and the Examiner's Answer ("Ans.," mailed January 6, 2009).

1

2

1. A display system comprising:

3

[1] a shelf assembly having at least a first and second side;

4

[2] one or more wall mounting assemblies for mounting to a  
wall and

5

6

comprising a slotting mechanism

7

for removably mounting a shelf mount assembly,

8

wherein the shelf assembly may be removed

9

without removing a wall mount

10

attachment mechanism from the one

11

or more wall mounting assemblies;

12

[3] a shelf mount assembly

13

for mounting to one or more wall mounting assemblies

14

through the slotting mechanism and

15

removably mounting the shelf assembly; and

16

[4] one or more display object mounting assemblies,

17

wherein each of the one or more display object mounting  
assemblies

18

19

removably and rotatably mount a display object to  
the first side of the shelf assembly,

20

21

such that the display object is rotatable about an  
axis for display purposes and

22

23

is removable from the shelf assembly;

24

[5] wherein the shelf assembly enables a person

25

to view at least a majority of the display object

26

from the second side of the shelf assembly.

1 THE REJECTIONS

2 The Examiner relies upon the following prior art:

|         |                 |               |
|---------|-----------------|---------------|
| Gregory | US 606,889      | Jul. 5, 1898  |
| Winter  | US D305,190     | Dec. 26, 1989 |
| Peters  | US 5,165,538    | Nov. 24, 1992 |
| Sickels | US 6,467,745 B1 | Oct. 22, 2002 |

3 Claims 1 and 5-7 stand rejected under 35 U.S.C. § 102(b) as anticipated  
4 by Gregory.

5 Claims 2, 3, 10-12, and 14-16 stand rejected under 35 U.S.C. § 103(a) as  
6 unpatentable over Gregory and Winter.

7 Claims 8, 9, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as  
8 unpatentable over Gregory, Winter, and Peters.

9 Claims 4 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
10 over Gregory, Winter, and Sickels.

11 ISSUES

12 The issue of whether the Appellants have sustained their burden of  
13 showing that the Examiner erred in rejecting claims 1 and 5-7 under  
14 35 U.S.C. § 102(b) as anticipated by Gregory turns on whether Gregory  
15 mounts its shelf to the desk or wall mount with a shelf mount.

16 The issue of whether the Appellants have sustained their burden of  
17 showing that the Examiner erred in rejecting claims 2, 3, 10-12, and 14-16  
18 under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter turns on

1 whether Winter's use of transparent material is predictable by Gregory's  
2 shelf.

3 The issue of whether the Appellants have sustained their burden of  
4 showing that the Examiner erred in rejecting claims 8, 9, 17, and 18 under  
5 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters turns  
6 on whether Peters' use of transparent mount is predictable by Gregory's  
7 shelf.

8 The issue of whether the Appellants have sustained their burden of  
9 showing that the Examiner erred in rejecting claims 4 and 13 under  
10 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Sickels turns  
11 on whether Sickels' use of a vertical shelf is predictable by Gregory's shelf.

## 12 FACTS PERTINENT TO THE ISSUES

13 The following enumerated Findings of Fact (FF) are believed to be  
14 supported by a preponderance of the evidence.

### 15 *Facts Related to the Prior Art*

#### 16 *Gregory*

17 01. Gregory is directed to a swinging support for mounting  
18 equipment such as a typewriter. Gregory 1:10-14.

19 02. Gregory describes a plate (Fig. 1:A) for securing the entire  
20 mechanism vertically by means of fasteners through holes (Fig.  
21 3:B). Gregory 1:37-47.

22 03. Gregory describes vertical holes or slots in the hinged lugs (Fig.  
23 1:C & D) that are attached to the plate (Fig. 1:A). Gregory 1:37-  
24 47.

04. Gregory describes a hinge pin (Fig. 1:H) attached to the upper center (Fig. 1:G) on shelf (Fig. 1:F) and thumb screw (Fig. 1:I) for attaching to the lower center (Fig. 1:G) on the shelf (Fig. 1:F).

The hinge pin and thumbscrew mount the shelf to the plate through the slots in the hinged lugs (Fig. 1:C & D). Gregory 1:48-60.

05. Gregory describes a combination of a disk (Fig. 1:N) and thumb nut (Fig. 1:O) allowing whatever is attached to rotate. Gregory has two holes (Fig. 1:P) to secure something to the disk.

*Winter*

06. Winter is a design patent directed to a display shelf (Winter Cover page: Description).

07. Winter Fig. 1 portrays a shelf made of transparent material that is offset at an acute angle.

*Peters*

08. Peters is directed to a device to hold souvenir balls. Peters 1:6-7.

09. Peters describes using a lower portion made of transparent material to support a display object (baseball in Peters). Peters 2:26-36.

*Sickels*

10. Sickels is directed to a mounting bracket. Sickels 1:7-9.

11. Sickels describes mounting brackets for adjustably supporting objects on walls and other support surfaces are well known. Sickels 1:12-14.

12. Sickels shows a mounting bracket in which the support surface is parallel to the wall. (Sickels Fig. 1:24).

# PRINCIPLES OF LAW

## Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

## Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).



In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

## ANALYSIS

*Claims 1 and 5-7 rejected under 35 U.S.C. § 102(b) as anticipated by Gregory.*

The Appellants contend that Gregory fastens its shelf to a desk rather than a wall; Gregory does not describe a slotting mechanism; and Gregory directly attaches the shelf assembly to the wall mount assembly. Appeal Br. 9.

As to Gregory's describing its plate as mounting to the side of a desk, claim 1 recites a display system and is therefore it is defined by its structural limitations and not by how it is used. *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997); *see also In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971);

Thus, the phrase “for mounting to a wall” in limitation [2] requires that the device be structurally capable of wall mount. Gregory describes a plate for securing the entire mechanism vertically by means of fasteners through holes. FF 02. Clearly, fasteners such as screws, can mount Gregory’s plate to a wall as well as to a desk.

1 As to a slotting mechanism, Gregory describes vertical holes or slots in  
2 the hinged lugs that are attached to the plate. FF 03. The Appellants argue  
3 that the necessity of a thumb screw obviates such a slotting mechanism.  
4 Reply Br. 4. This argument was not presented in the original Appeal Brief.

5 However, even taking the argument on its face, the argument ignores the  
6 lower hole or slot that the thumb screw passes through. FF 04. The only  
7 structural requirement of the slotting mechanism is that it allow the shelf  
8 assembly to be removed without removing a wall mount attachment  
9 mechanism from the wall mounting assembly. Clearly the screws  
10 (corresponding to the wall mount attachment mechanism) that attach  
11 Gregory's plate to a desk (or wall) do not have to be removed for Gregory's  
12 shelf to be removed from the plate. All that is required is to unscrew the  
13 thumb screw and lift the shelf to clear the hinge pin.

14 Finally we come to the third argument, again repeated in the Reply Brief  
15 at 3-4. This argument contends that Gregory's shelf mount assembly is  
16 inseparable from Gregory's shelf assembly. Appeal Br. 9; Reply Br. 3. This  
17 argument is not commensurate with the scope of the claims. Limitation [3]  
18 requires that the shelf mount assembly be mountable to the wall mounting  
19 assembly through the slotting mechanism and allows the shelf assembly to  
20 be removably mounted. There is no requirement that the shelf and shelf  
21 mount be separable. To the extent the Appellants are arguing that the last  
22 phrase in limitation [3] poses such a requirement, that phrase does not  
23 specify the structure from which the shelf assembly is to be removed, so the  
24 property of Gregory's shelf being removable from the plate (corresponding  
25 to the claimed wall mount) reads on this phrase in the limitation.

1 As to claims 5, 6, and 7, separately argued (Appeal Br. 10-11), these  
2 claims require that the display be capable of mounting a model car (claim 5);  
3 a packaging attachment mechanism to secure a display object to a retrofit  
4 bracket, the retrofit bracket being rotatably and removably secured to the  
5 shelf (claim 6); and the retrofit bracket having one side capable of being  
6 secured to a display object and a second side being secured to the shelf  
7 assembly (claim 7). As the Examiner found (Ans. 3), a model car can  
8 readily be mounted to Gregory's disk via its mounting holes (Gregory Fig  
9 1:N); Gregory's disk (corresponding to the claimed retrofit bracket) is  
10 rotatably and removably secured to the shelf with a thumb nut  
11 (corresponding to the claimed packaging attachment mechanism); and  
12 Gregory's disk has one top side to which something to be displayed may be  
13 secured with the two mounting holes and the other side of the disk is secured  
14 to the shelf. (FF 05).

15 *Claims 2, 3, 10-12, and 14-16 rejected under 35 U.S.C. § 103(a) as*  
16 *unpatentable over Gregory and Winter.*

17 Claim 2 further requires that the shelf be transparent and claim 3 that the  
18 shelf be at an acute angle. The Examiner applied Winter for these  
19 limitations. Ans. 4-5. The Appellants again argue that these claims are  
20 patentable for incorporating the limitations of parent claim 1 and also that  
21 Winter does not describe the transparent material and acute angle. The  
22 Appellants also argue a lack of motivation in the prior art. Appeal Br. 11-  
23 12. We disagree with the Appellants.

24 Winter Fig. 1 portrays a display shelf made of transparent material that is  
25 offset at an acute angle. FF 06 & 07. As to motivation,

1 [t]he obviousness analysis cannot be confined by a formalistic  
2 conception of the words teaching, suggestion, and motivation,  
3 or by overemphasis on the importance of published articles and  
4 the explicit content of issued patents. The diversity of inventive  
5 pursuits and of modern technology counsels against limiting the  
6 analysis in this way. In many fields it may be that there is little  
7 discussion of obvious techniques or combinations, and it often  
8 may be the case that market demand, rather than scientific  
9 literature, will drive design trends.

10 *KSR*, 550 U.S. at 419.

11 The combination of familiar elements according to known methods is  
12 likely to be obvious when it does no more than yield predictable results.” *id.*  
13 550 U.S. at 416. Where, as here “[an application] claims a structure already  
14 known in the prior art that is altered by the mere substitution of one element  
15 for another known in the field, the combination must do more than yield a  
16 predictable result,” *Id.* 550 U.S. at 416 (citing *United States v. Adams*, 383  
17 U.S. 50-51 (1966)). The Examiner articulated reasoning with rational  
18 underpinning that one of ordinary skill would have modified Gregory with  
19 transparent material to focus visual attention (Final Rej. 4) and with an acute  
20 angle to protect against having a display object fall to the floor if detached  
21 (Ans. 9.)

22 Our analysis of why the parent claim is unpatentable is shown *supra*.  
23 Claims 10-12 and 14-16 are to various combinations of claims 1-3 and 5-7.  
24 The arguments are similar to those presented for claims 1-3 and 5-7 and we  
25 find them equally unpersuasive here.

26 *Claims 8, 9, 17, and 18 rejected under 35 U.S.C. § 103(a) as*  
27 *unpatentable over Gregory, Winter, and Peters.*

28 Claim 8 further requires that the retrofit bracket enable a person to view  
29 at least a majority of the display object's surface through the retrofit bracket

1 and claim 9 that retrofit bracket be transparent. The Examiner applied  
2 Winter for these limitations. Ans. 5-6. The Appellants again argue that  
3 these claims are patentable for incorporating the limitations of parent claim 1  
4 and also that Winter does not describe the transparent material and viewing  
5 enablement. The Appellants also argue a lack of motivation in the prior art.  
6 Appeal Br. 18-19. We disagree with the Appellants.

7 Peters describes using a lower portion made of transparent material to  
8 support a display object. FF 09. This lower portion corresponds to the  
9 claimed retrofit bracket, because Peters' lower portion secures its display  
10 object. Because the lower portion is transparent, it enables a person to view  
11 at least a majority of the display object's surface through the lower portion.

12 The Examiner repeated the rationale from claims 2 and 3 for modifying  
13 Gregory with transparent material. Ans. 12-13.

14 Claims 17 and 18 are essentially the same as claims 8 and 9. The  
15 arguments are similar to those presented for claims 8 and 9 and we find them  
16 equally unpersuasive here.

17 *Claims 4 and 13 rejected under 35 U.S.C. § 103(a) as*  
18 *unpatentable over Gregory, Winter, and Sickels.*

19 Claim 4 further requires mounting the shelf assembly parallel to the  
20 wall. The Examiner applied Sickels for this limitation. Ans. 6. The  
21 Appellants again argue that these claims are patentable for incorporating the  
22 limitations of parent claim 1 and also that Sickels does not describe the  
23 mount parallel to the wall. The Appellants also argue a lack of motivation in  
24 the prior art. Appeal Br. 20-21. We disagree with the Appellants.

1 Sickels shows a mounting bracket in which the support surface is  
2 parallel to the wall. FF 12. Sickels also describes mounting brackets for  
3 adjustably supporting objects on walls and other support surfaces as being  
4 well known. Thus, Sickels does no more than demonstrate a way of  
5 providing a well known mount.

6 The Examiner articulated a rationale with rational underpinning for  
7 modifying Gregory with a bracket that can be moved to any vertical angle  
8 for the purpose of accommodating the decreasing distance from the  
9 mounting surface as Gregory's shelf is swung about its pivots. Ans. 14.

10 Claim 13 is essentially the same as claim 4. The arguments are similar  
11 to those presented for claim 4 and we find them equally unpersuasive here.

#### 12 CONCLUSIONS OF LAW

13 The Appellants have not sustained their burden of showing that the  
14 Examiner erred in rejecting claims 1 and 5-7 under 35 U.S.C. § 102(b) as  
15 anticipated by Gregory.

16 The Appellants have not sustained their burden of showing that the  
17 Examiner erred in rejecting claims 2, 3, 10-12, and 14-16 under 35 U.S.C.  
18 § 103(a) as unpatentable over Gregory and Winter.

19 The Appellants have not sustained their burden of showing that the  
20 Examiner erred in rejecting claims 8, 9, 17, and 18 under 35 U.S.C. § 103(a)  
21 as unpatentable over Gregory, Winter, and Peters.

22 The Appellants have not sustained their burden of showing that the  
23 Examiner erred in rejecting claims 4 and 13 under 35 U.S.C. § 103(a) as  
24 unpatentable over Gregory, Winter, and Sickels.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1 and 5-7 under 35 U.S.C. § 102(b) as anticipated by Gregory is sustained.
- The rejection of claims 2, 3, 10-12, and 14-16 under 35 U.S.C. § 103(a) as unpatentable over Gregory and Winter is sustained.
- The rejection of claims 8, 9, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Peters is sustained.
- The rejection of claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over Gregory, Winter, and Sickels is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Vsh

HUNTON & WILLIAMS LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON DC 20006-1109